ESTTA Tracking number: **ESTTA190092**

Filing date: **01/31/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91175750
Party	Plaintiff Swinger International S.p.A.
Correspondence Address	Angelo Notaro Notaro & Michalos P.C. 100 Dutch Hill Road, Suite 110 Orangeburg, NY 10962 UNITED STATES anotaro@notaromichalos.com
Submission	Motion for Sanctions
Filer's Name	Angelo Notaro
Filer's e-mail	anotaro@notaromichalos.com
Signature	/G96-176-AN/
Date	01/31/2008
Attachments	G96-176 Default Judgment.pdf (8 pages)(305130 bytes)

G96-176

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/831,113
Filed March 7, 2006
For the mark BYBLE (Stylized)
Published in the Official Gazette on November 17, 2006

Swinger International SPA,	
	Opposition No. 91175750
Opposer,	
v.	
Tsz Wai Cheng,	
Applicant.	

COMBINED MOTION FOR DEFAULT JUDGMENT AND MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR DEFAULT JUDGMENT

Opposer, Swinger International SPA ("Opposer" or "Swinger"), by and through its undersigned counsel, hereby moves for judgment by default to be entered against Applicant, Tsz Wai Cheng ("Applicant" or "Cheng"), as a sanction pursuant to 37 C.F.R. § 2.120(g)(1), and in support thereof asserts the following.

I. BACKGROUND

The background of this case is set forth in detail in Opposer's Motion to Compel Responses to Opposer's Discovery Requests and the supporting Declaration of Angelo Notaro.

To summarize, the instant opposition proceeding was commenced by Opposer on

February 20, 2007, against Applicant's pending trademark application for BYBLE (Stylized), Serial Number 78/831,113. Opposer is the owner of U.S. Registration No. 1,122,426 for BYBLOS for jackets, trench coats, overcoats, shirts, skirts, pants, T-shirts, belts, scarves and kerchiefs.[1]

The grounds for the opposition are that Opposer believes that a likelihood of confusion would result from registration of Applicant's BYBLOS mark.

Aside from filing an Answer to Opposer's Notice of Opposition, Applicant has failed to participate in this proceeding. More than eight months have passed since Applicant was first served with Opposer's discovery requests. Even after Opposer moved to compel production, and the Board ordered such production, Applicant failed to produce any discovery.

Opposer respectfully submits that as Applicant has completely abdicated any role in this proceeding, has failed to engage in discovery, and has flagrantly ignored the Board's Order compelling discovery, the entry of a default judgment is proper. *See* 37 C.F.R. § 2.120(g)(1). For these reasons, Opposer's Motion for Default should be granted.

II. FACTS

The facts of this case demonstrate that default judgment is appropriate.

Applicant has acted in a manner that implicitly indicates it will not participate in this proceeding as it has failed to respond to Opposer's outstanding discovery requests, Opposer's Motion to Compel, and the Board's Order to produce discovery.

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[1]Opposer also has plead use of the BYBLOS mark and trade name in connection with the registered goods from a date prior to applicant's filing date.

Opposer served Applicant with its first set of discovery requests on May 23, 2007. Applicant did not request an extension of time in which to respond and, to date, no responses have been provided.

Faced with Applicant's refusal to participate in discovery, Opposer filed a Motion to Compel Responses to Opposer's Discovery Requests on August 27, 2007 in order to move forward to some resolutions of this proceeding.

On November 2, 2007, the Board issued an Order suspending the proceeding pending the disposition of the Motion to Compel. The Order provided that it did **not** toll the time for either party to respond to outstanding discovery requests. (Emphasis in original).

After Applicant failed to respond to Opposer's Motion to Compel, on November 2, 2007, the Board granted the Motion as conceded and ordered Applicant to respond to Opposer's First Request for Production of Documents and Opposer's First Set of Interrogatories within thirty days from the mailing date of the Order - - on or before December 3, 2007. Applicant has ignored the Board's Order and has not, to date, provided any discovery to Opposer.

III. ARGUMENT

Trademark Rule 2.120 (g)(1) authorizes sanctions against a party that fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery. 37 C.F.R. § 2.120(g)(1).

The sanctions available to the Board include the full range of sanctions provided for in Rule 37(b)(2) of the Federal Rules of Civil Procedure, including "rendering a judgment

by default against the disobedient party." Fed.R.Civ.P. 37(b)(2)(c). While default judgment is a harsh remedy, it is justified where, as here, there is a strong showing of willful evasion. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.,* 55 U.S.P.Q.2d 1848, 1854 (T.T.A.B. 2000). Here, the entry of default judgment is entirely justified based on Applicant's refusal to participate in this proceeding.

(a) **Applicant Has Completely Failed to Respond to the Board's Order to Provide Responses to Opposer's Outstanding Discovery Requests**

Trademark Rule 2.120(g)(1) provides that a party must obey an order to provide discovery. In the instant case, it is undisputed that the Board's November 2, 2007 Order compelled Applicant to respond to Opposer's First Request for Production of Documents and Opposer's First Set of Interrogatories. In willful violation of that Order, Applicant has refused to provide Opposer with any discovery. As Applicant has failed to comply with the Board's Order, it has subjected itself to sanctions.

(b) **Default Judgment is the Most Appropriate Sanction**

Default judgment is appropriate given the egregious circumstances present in this case.

Applicant has failed to participate in discovery, ignored Opposer's communications regarding discovery, failed to respond to Opposer's Motion to Compel, and has ignored the Board's November 2, 2007 Order compelling production.

Applicant's conduct has unnecessarily protracted this proceeding and needlessly obstructed the resolution of the dispute on its merits.

As Applicant has ignored both Opposer's Motion to Compel and the Board's Order granting such motion, it is reasonable to assume that Applicant will ignore further Order's of the Board. Thus, the only sanction that would provide Opposer with appropriate relief is granting judgment in its favor. *Unicut Corp. v. Unicut, Inc.*, 222 U.S.P.Q.341 (T.T.A.B. 1984).

As Opposer highlighted in its Motion to Compel, it is well established that litigants "cannot be permitted to frustrate discovery by refusing to comply with a proper request." *Al Barnett & Sons, Inc. v. Outboard Marine Corp.*, 611 F.2d 32, 35 (3d Cir. 1979) (citing *Cine Forty-Second Street Theatre v. Allied Artists Pictures Corp.*, 602 F.2d 1062, 1068-69 (2d Cir. 1979)) (Oakes, J., concurring). "To permit litigants to disregard the responsibilities that attend the conduct of litigation would be tantamount to 'encouraging dilatory tactics.'" *Id.*

The Board has recognized that default judgment is an appropriate remedy when one party, such as Applicant in the instant matter, has refused to participate in the proceeding, failed to comply with the Board's Order, and has avoided its discovery responsibilities. *See MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG,* 59 U.S.P.Q. 2d at 1854; *Unicut Corp. v. Unicut, Inc.*, 222 U.S.P.Q.341, 344 (T.T.A.B. 1984).

In *Baron Philippe de Rothschild S.A.,* the Opposer moved for a default judgment after the Applicant failed to comply with the Board's Order to produce the outstanding discovery responses and failed to produce a witness for deposition. The Board granted sanctions in the nature of an entry of default judgment after finding that "applicant and its counsel have engaged in a pattern of dilatory tactics, have purposely avoided applicant's

discovery responsibilities in this case, and have willfully failed to comply with the Board's January 6, 1999 order." *Id.,* 55 U.S.P.Q.2d at 1854.

Similarly in *MHW Ltd.,* the Applicant moved for a default judgment after the Opposer repeatedly failed to meet its discovery obligations and comply with the Board's Orders. The Board granted default judgment after finding that:

> It is obvious from a review of the record that opposers have been engaging for years in delaying tactics, including the willful disregard of the Board's orders. Opposer's protestations that their attempts at compliance have been diligent are unconvincing, and their reasons for delay are undetermined by their obvious failure to take any action within the Board ordered periods for responding to applicant's discovery requests. We agree with applicant that the responses and supplements to responses served on applicant demonstrate opposer's intent to continue to delay this proceeding by setting up obstacles to applicant's receipt of clearly relevant information.

Id., 59 U.S.P.Q.2d at 1478-79.

Moreover, in *Unicut Corp.,* the Board granted default judgment after finding that:

> Respondent has repeatedly acted in a m anner to evade discovery properly attempted by petitioner. Respondent's willful failure to comply with the November 18, 1983 order of the Board after having been advised of the possible consequences warrants the sanction requested by petitioner. Petitioner's third motion for sanctions is granted, judgment is hereby entered against respondent, the petition for cancellation is granted, and Registration No. 846,659 will be cancelled in due course.

Id., 222 U.S.P.Q. at 344.

Here, the entry of default judgment is warranted as Applicant has failed to comply with the rules pertaining to *inter partes* discovery and proceedings and has willfully disregarded the Board's November 2, 2007 Order.

Applicant's nonfeasance has unfairly increased the cost to Opposer. Opposer has had to file the present motion and its prior motion with the Board in an effort to obtain Applicant's proper compliance with the applicable rules governing *inter partes* proceedings. As it is unfair to force Opposer to litigate against itself in this proceeding, Opposer respectfully requests that the Board enter judgment against Applicant.

IV. CONCLUSION

Based on the complete and total lack of activity on Applicant's part in matter for over a year, the only reasonable conclusion one could reach is that Applicant has lost interest in its trademark application and, accordingly, in this opposition proceeding.

Opposer respectfully submits that the only appropriate sanction is the entry of a default judgment against Applicant. Accordingly, Opposer respectfully moves for a default judgment as a sanction under 37 C.F.R. § 2.120(g)(1).

Dated: January 31, 2008

Respectfully submitted,

NOTARO & MICHALOS P.C.
Attorneys for Opposer

By: _____
Angelo Notaro
John Zaccaria
100 Dutch Hill Road, Suite 110
Orangeburg, New York 10962-2100
Phone: (845) 359-7700
Fax: (845) 359-7798
E-Mail: anotaro@notaromichalos.com

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing **COMBINED MOTION FOR DEFAULT JUDGMENT AND MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR DEFAULT JUDGMENT** has been served by causing a copy thereof to be sent first class mail, postage prepaid, on January 31, 2008 to the Attorney for Applicant addressed to:

Jeffrey S. Dweck, Esq.
100 West 33rd Street, Suite 1017
New York, New York 10001

Pharah Miranda

Pharah Miranda